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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/649,047

08/26/2003

Michael D. Laufer

035555-000003

4977

7590

09/27/2006

Robert E. Krebs  
Thelen Reid & Priest, LLP  
P.O. Box 640640  
San Jose, CA 95164-0640

EXAMINER

ROLLINS, ROSILAND STACIE

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/649,047	<b>Applicant(s)</b> LAUFER ET AL.	
	<b>Examiner</b> Rosiland S. Rollins	<b>Art Unit</b> 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) 18-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17, 32-64 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Species I in the reply filed on 7/10/06 is acknowledged. The traversal is on the ground(s) that the restriction requirement is unclear. Applicant has requested a new restriction requirement between the method and apparatus claims. The requested requirement is as follows.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-17, 32-64, drawn to an apparatus to excise tissue, classified in class 606, subclass 045.
- II. Claims 18-31, drawn to a method for excising tissue sample from a body, classified in class 128, subclass 898.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another and materially different apparatus that does not include a connection to a medical device.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required

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because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

In the response filed 7/10/06 to the original restriction requirement a provisional election was made without traverse to prosecute the invention of group I claims 1-17 and 32-64. Claims 18-31 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 7-9, 15-17, 32-40, 45-52, 54-56 and 62-64 are rejected under 35 U.S.C. 102(b) as being anticipated by Willink et al. (US 6254600). Willink et al. disclose an apparatus to excise tissue comprising a conducting element (1240) configured to receive power, an insulating holder (1208) coupled to the conducting element and a connector coupled to the insulating holder for connection to a medical device (col. 12

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line 56 – col. 13 line 14. Willink et al. disclose the conducting element as being made of a conducting material in col. 33 lines 1-10. Moreover, Willink et al. disclose the insulating holder as being made of ceramic in col. 32 lines 41-51.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6, 41 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Willink et al. in view of Eggers et al. (US 6113597). Willink et al. teach all of the limitations of the claims except the conducting element including a plurality of micro-fractures. Eggers et al. disclose a similar device and teach that it is old and well known in the art to provide micro-fractures on a conducting element to promote localized high current densities to facilitate ablation or cutting of the tissue. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a plurality of micro-fractures on the conducting element of Willink et al. to promote localized high current densities to facilitate ablation of cutting of the tissue.

Claims 10 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Willink et al. in view of Passafaro et al. (US 6139557). Willink et al. teach all of the limitations of the claims except the electrical wire being secured with a spring tension device and a friction tension device. Passafaro et al. disclose a surgical device and teach that it is old and well known in the art to secure a wire with a spring tension and

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friction tension device to maintain the tension of the wire. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to secure the electrical wire of Willink et al. with a spring tension device and a friction tension device as taught by Passafaro et al. to maintain the tension of the electrode wire of Willink et al.

Claims 11, 12, 42 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Willink et al. in view of Broadwin et al. (US 4931047). Willink et al. teach all of the limitations of the claims except a vibrating mechanism being coupled to the conducting element. Broadwin et al. disclose a similar device and teach that it is old and well known in the art to couple a vibrating mechanism to a conducting element to help increase the rate of tissue removal. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to couple a vibrating mechanism to the conducting element of Willink et al. to increase the rate of tissue removal.

Claims 13, 14, 43, 44, 60 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Willink et al. in view of Edwards et al. (US 6077257). Willink et al. teach all of the limitations of the claims except a temperature sensor and an impedance sensor coupled to the conducting element. Edwards et al. disclose a similar device and teach that it is old and well known in the art to couple a temperature sensor and an impedance sensor to a conducting element to provide feedback control to the power supply. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to couple a temperature sensor and an impedance sensor


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to the conducting element of Willink et al. as a means of providing feedback control to the power supply of the device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosiland S. Rollins whose telephone number is (571) 272-4772. The examiner can normally be reached on Mon.-Fri. 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Rosiland S Rollins  
Primary Examiner  
Art Unit 3739